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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,883	11/08/2000	Naohiko Matsuda	PM272992	1379

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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 11/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,883

Applicant(s)

MATSUDA ET AL.

Examiner

Jessica L. Rossi

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/1/02, Amendment B, paper no. 8.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/294,713.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 10/1/02. Claims 1-3 are pending.
2. The rejection of claims 1-2 under 35 U.S.C. 103(a) as being unpatentable over Lindstrom et al. (of record) in view of Kuhnhold et al. (of record) as set forth in the previous office action has been withdrawn in light of Applicants arguments.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Doderer-Winkler (US 5429576).

With respect to claim 1, Doderer-Wikler, directed to a method for attaching adhesive tapes 32 and 42, teaches disposing the adhesive tapes on a support body 74 such that their adhesive surfaces 40 and 52, respectively, are in contact with the support body (Figure 1; column 5, lines 20-31; column 7, lines 19-27). The reference teaches rolling an attaching roller 78, having adhesive strength, on an opposite, non-adhesive side surface of the tapes so that the tapes are transferred onto the attaching roller and held tightly against it (Figure 1; column 7, lines 52-63; column 8, lines 4-8) and rolling the attaching roller on a surface of a member 10 so that the adhesive tapes are transferred and attached to the surface of the member (Figure 1; column 8, lines 20-27).

The reference teaches the support body having a low friction surface, such as Teflon® (column 7, lines 37-38), so that adhesion of the tapes to the support body can be overcome by the attaching roller (column 8, lines 4-8). Therefore, the adhesive strength between the non-adhesive surface of the tapes and the attaching roller (B) is greater than the adhesive strength between the adhesive surface of the tapes and the support body (A). The reference also teaches the adhesive strength between the adhesive surface of the tapes and the member (C) being greater than the adhesive strength between the non-adhesive surface of the tapes and the attaching roller (B) (column 8, lines 21-25).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doderer-Winkler in view of Rodriguez (US 5178717).

With respect to claim 1, the examiner interpreted the Doderer-Winkler reference to mean that the attaching roller has an adhesive strength. If it is not taken that the attaching roller has adhesive strength, the examiner directs Applicant's attention to the present specification and the reference to Rodriguez. The present specification teaches the attaching roller having adhesive strength because it has silicon rubber in its surface layer or its whole layer (page 8, lines 14-17).

It is known in the art to attach double-sided adhesive tape 20 to a member 10 by disposing the tape on a support body 21, which passes around a roller 14, and rolling an attaching roller 13 on an opposite side of the tape so that the tape is removed from the support body and transferred to the attaching roller, which then transfers the tape to the member, as taught by Rodriguez

Art Unit: 1733

(Figure 1; column 2, lines 56-65). This transfer takes place because the attaching roller is made of silicone rubber, which is tacky enough to remove the tape from the support body but not so tacky that it will not release the tape to the member (column 3, lines 15-20). The reference also teaches the elastic nature of the silicone rubber roller being advantageous, because it provides an even pressure against the roller 14 and the member 10 (column 3, lines 7-11).

Doderer-Winkler teaches that the attaching roller 78 may have vacuum holes to overcome the adhesive strength between the low friction surface of the support body 74 and the adhesive surface of the tape and thereby ensuring proper transfer of the tape to the attaching roller (column 8, lines 4-10; column 7, lines 37-41). However, one reading the reference as a whole would have appreciated that the use of vacuum is not critical to the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a silicone rubber roller for the attaching roller of Doderer-Winkler as an alternative to vacuum because such an attaching roller is known in the art, as taught by Rodriguez, and silicone rubber exhibits adhesive strength that would overcome the adhesive strength between the support body and the adhesive surface of the tape, as required by Doderer-Winkler. Furthermore, the elasticity of the silicone rubber roller would provide an even pressure against the support body and the member.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kluger (US 3713948) in view of the collective teachings of Lindstrom et al. (of record; US 4321103) and Adachi (of record; US 4468274), and Rodriguez.

With respect to claim 1, Kluger, directed to a method for attaching adhesive tape 17 (column 2, line 67 – column 3, line 1), teaches disposing the tape on a conveyor belt 35 (Figure

Art Unit: 1733

1; column 2, lines 26-28), rolling an attaching roller 12 on an opposite non-adhesive surface of the tape so that the tape is transferred onto the attaching roller and held tightly against it (Figure 1; column 2, lines 54-61), and rolling the attaching roller on a surface of a member 15 so that the tape is transferred and attached to the surface of the member (Figure 1; column 2, line 67 – column 3, line 4). The reference is silent as to an adhesive surface of the tape contacting the conveyor belt, the attaching roller having an adhesive strength, and $A < B < C$.

The reference teaches the tape being attached to the member by means of adhesive but is silent as to when the adhesive is applied to the tape. It is known in the art to attach a tape having a pre-formed adhesive layer to a member by disposing the tape on a conveyor belt, such that the adhesive side of the tape is in contact with the conveyor belt, and removing the tape from the conveyor belt to attach it to the member, as taught by the collective teachings of Lindstrom (Figure 3; column 2, lines 45-53) and Adachi (Figure 2; column 3, lines 22-30); the conveyor belt being surface treated to ensure removal of the tape from the conveyor belt (Lindstrom; column 2, lines 45-48; Adachi; column 3, lines 26-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a pre-formed adhesive layer on the side of the tape of Kluger that is in contact with the conveyor belt, wherein the conveyor belt is surface treated to ensure removal of the tape from the conveyor belt by means of the attaching roller, because such is known in the art, as taught by the collective teachings of Lindstrom and Adachi, and this simplifies the apparatus by eliminating the need for an adhesive applicator.

It is known in the art to attach double-sided adhesive tape 20 to a member 10 by disposing the tape on a support body 21, which passes around a roller 14, and rolling an attaching roller 13

Art Unit: 1733

on an opposite side of the tape so that the tape is removed from the support body and transferred to the attaching roller, which then transfers the tape to the member, as taught by Rodriguez (Figure 1; column 2, lines 56-65). This transfer takes place because the attaching roller is made of silicone rubber, which is tacky enough to remove the tape from the support body but not so tacky that it will not release the tape to the member (column 3, lines 15-20). The reference also teaches the elastic nature of the silicone rubber roller being advantageous, because it provides an even pressure against the roller 14 and the member 10 (column 3, lines 7-11).

Kluger teaches that the attaching roller 12 having vacuum holes to remove the tape from the conveyor belt and hold it in place on the attaching roller (column 2, lines 54-65). However, one reading the reference as a whole would have appreciated that the use of vacuum is not critical to the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a silicone rubber roller for the attaching roller of Kluger as an alternative to vacuum because such an attaching roller is known in the art, as taught by Rodriguez, and silicone rubber exhibits adhesive strength that would overcome the adhesive strength between the conveyor belt and the adhesive surface of the tape. Furthermore, the elasticity of the silicone rubber roller would provide an even pressure against the conveyor belt and the member.

In view of these modifications, the skilled artisan would now readily appreciate that the adhesive strength between the adhesive surface of the tape of Kluger and the conveyor belt is less than the adhesive strength between the non-adhesive surface of the tape and the attaching roller, which is less than the adhesive strength between the adhesive surface of the tape and the member.

Art Unit: 1733

Regarding claim 2, please refer to claim 1.

Regarding claim 3, Kluger teaches using a knife 45 to cut a tape 18 into tape pieces 17 prior to disposing the tape pieces on the conveyor belt (Figure 1; column 2, lines 25-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to supply the tape 18 in roll-form because such is known in the art, as taught by Adachi (Figure 2), and this allows the tape to be stored and continuously supplied throughout operation of the apparatus.

Response to Arguments


8. Applicant's arguments filed 10/1/02 have been fully considered but they are not persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700

Application/Control Number: 09/707,883


Page 8

Art Unit: 1733

Jessica L. Rossi
Patent Examiner
Art Unit 1733



jl
November 6, 2002


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